IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of	Confirmation No.: 3475
Jerome D. JOHNSON et al.	Group Art Unit: 3686
Application No.: 09/739,448	Examiner: PASS, Natalie
Filed: December 18, 2000	Attorney Docket. No.: P65332

For: SYSTEM AND METHOD FOR PROVIDING CONFIGURATION AND SALES
      INFORMATION TO ASSIST IN THE DEVELOPMENT OF INSURANCE PLANS

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

   This is a Reply Brief to the Examiner's Answer dated October 29, 2010. The Examiner
presented new arguments in the Answer. Specifically, the Examiner, at pages 28-32 of the
Answer, provided claim charts which had not been provided in the previous Office Actions,
wherein the Examiner cited new portions of Warady to assert that it discloses the claimed two
distinct indication features as further discussed in the following remarks.

   Thus, Appellant submits that this Reply Brief includes arguments necessary to rebut the
Examiner's new arguments provided in the Answer. This Reply Brief does not include any new or
non-admitted amendment, or any new or non-admitted affidavit or other evidence as required by
37 CRF 41.41(a)(2), and therefore consideration of this Reply Brief is respectfully solicited.

   This Reply Brief is being timely filed within two months from the date of the Examiner's
Answer, not expiring until December 29, 2010.

   Turning to the points made by the Examiner in her Answer, which Appellant wishes to
rebut:

I.   BACKGROUND OF THE INVENTION

The present invention relates to methods and systems for generating a customized insurance proposal, using an automated computer system that includes a database and configuration rules.

In particular, embodiments of the present invention allow for determining if a particular insurance plan may be proposed, but is not currently configured for a customer (the determination being based upon, for example stored plan requirements data and either stored customer data or user selected plan options), and presenting a description of insurance plan options on a display device of the computer system. The description includes an indication that a particular insurance plan being proposed is not currently configured for the customer, and an indication of what conditions are not met for the customer to qualify for the proposed, but currently not configured, insurance plan.

By virtue of the features and advantages afforded by the present invention, an insurance salesperson is able to easily and quickly determine which of several available insurance products would suit an individual customers' needs, and to prepare and provide a complete proposal for the customer based upon all of the best information that is currently available. This ensures that the best configuration of insurance products will be made available to a customer given a particular set of needs and constraints.

Unlike the presently claimed methods and systems, the primary reference, Lockwood, discloses a remotely located automated terminal (system) providing insurance quotations, making sales, and taking orders from customers. Lockwood does not disclose determining if a particular insurance plan may be proposed but is not currently configured for a customer based upon stored plan requirements data, and presenting a description of insurance plan options including an

indication that the particular insurance plan being proposed is not currently configured for the customer and an indication of what conditions are not met for the customer to qualify for the proposed, but currently not configured, insurance plan.

Further, a secondary reference, Warady, relates to a health and welfare benefit enrollment and billing system, wherein an employee can select a benefit option by filling out an enrollment form provided by a provider. As such, Warady simply teaches providing the enrollment form containing available options for the employee, and does not teach a method of generating a customized insurance proposal that includes determining if a particular insurance plan may be proposed but is not currently configured for a customer based upon stored plan requirements data, and presenting a description of insurance plan options including an indication that the particular insurance plan being proposed is not currently configured for the customer and an indication of what conditions are not met for the customer to qualify for the proposed, but currently not configured, insurance plan.

II. INDEPENDENT CLAIMS 1, 11, 30, 50-52, and 55

A. TWO DISTINCT INDICATIONS ARE REQUIRED BY THE INDEPENDENT CLAIMS

The independent claims require two distinct indications, namely:

"an indication that the particular insurance plan being proposed is not currently configured for the customer" (termed the 'first' indication, herein), and

"an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan" (herein termed the 'second' indication).

i. The First Indication

The first indication required by the independent claims is "an indication that the particular

insurance plan being proposed is not currently configured for the customer" (*emphasis added*).

The Examiner asserts that this feature is taught by Warady, but this conclusion is flawed:

Examiner's Answer		Appellant's Reply
Citation	Relevant Quotations	
Warady, at column 9, line 58 to column 10, line 8	In step S2, the health and welfare benefit enrollment and billing system 1 generates a blank enrollment form for each employee described in the employee data files 20 and eligible to receive one or more benefits. The blank enrollment forms are generated according to the data and instructions entered into the benefit files 10, the employee data files 20, the sponsor file 30, and the code file 40 in step S1 and are individualized for each employee to include, for example, all benefit plans and coverage options that are available to be selected by the employee [i.e. "not currently configured for the customer"] as well as prices and credits (if any) associated with each benefit plan and coverage option. Again, the information included in each enrollment form can be based [i.e. "not currently configured for the customer"], for example, on relevant characteristics of the employee, such as job classification, division, work location, age and salary, and rules established by the	Warady's enrollment forms that specify "all benefits plans and coverage options" are not "an indication that [a] particular insurance plan being proposed is not currently configured for [a] customer". Indeed, Warady specifically indicates that any plans listed on such a form are available to be selected by the employee. If anything, this is an indication that these listed plans are currently configured for the employee (after all, if they are available for selection, it follows that these plans have been configured in order to permit such selection; plans not so configured could not be selected). In other words, the passages from Warady which the Examiner relies upon in rejecting the present claims actually support the proposition that Warady teaches away from the present invention. By teaching a process in which only plans that are configured for a customer are presented (via the form) to the customer, Waraday does exacly opposite of what is being claimed (i.e., providing an indication that the particular insurance plan being proposed is *not* currently configured for the customer). Examining the examples provided in Figures 7a-7e of Warady do not alter this conclusion inasmuch as the example enrollment form for Sarah Shan, which was generated based on previously entered employee information, is generated based on relevant characteristics of

employer. An example of a blank enrollment form is shown in FIGS. 7a-7e. (*Examiner's interpretation is added in brackets, and emphasis/underlining is added by the Examiner*)	the employee, such as job classification, division, work location, age and salary, and rules established by the employer, and has nothing to do with whether or not the proposed plan is currently configured for the customer or not. Accordingly, Warady does not teach the claimed feature of "an indication that the particular insurance plan being proposed is not currently configured for the customer."

ii. Second Indication

The second indication required by the independent claims is "<u>an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan</u>" (*emphasis added*). Here again, the Examiner's conclusion that this feature is taught by Warady finds no support in the reference itself.

Examiner's Answer		Appellant Reply
Citation	Relevant Quotations	
Warady, at column 5, line 65 to column 6, line 11	The prerequisites table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have <u>prerequisites that must be met before an employee can be enrolled</u> in the plans. For example, certain life insurance plans require <u>evidence of insurability</u> of an employee to be approved by the plan provider <u>before the employee is eligible</u> to receive the chosen benefit or level of coverage. In this example, the prerequisites	As discussed on pages 17-19 of the Appeal Brief, Warady's teachings concerning allowing potential insures to see what prerequisites are required for the plans being offered do not equate to an indication of <u>what conditions are not met</u> for the customer to qualify for the proposed but currently not configured insurance plan. A list of prerequisites does not inform a customer of what conditions are not satisfied by the customer. For example, a potential customer may have no idea whether he or she possesses the requisite evidence of insurability described by Waraday, even if such a prerequisite is listed. Indeed, many, if not most, potential customers will have no idea

	table 110 could store information describing the conditions under which evidence of insurability is required by the plan provider ...	what such a certificate even is, let alone whether he or she has one. To suggest that simply providing a list of prerequisites equates to an indication of what conditions are not met for the customer to qualify is to imbibe the cited reference with knowledge gleaned only from the present application itself and thereby engage in impermissible hindsight reconstruction of the present invention in the prior art. Such actions cannot be a basis for rejections of the present claims.
Warady, at column 12, line 65 to column 13, line 12	Finally, as an additional feature to facilitate efficient reporting to participating plan providers of accurate information needed about participating employees, the health and welfare benefit enrollment and billing system 1 can create various supplemental reports. These supplemental reports can include, for example, an "Underwriters' Exception Report," which is generated periodically (typically monthly or with each billing statement) and which lists employees having exceptional circumstances, such as those awaiting evidence of insurability, those on disability, and those whose employment terminated during the period, and an "Employee Census Report," which is generated on demand and which lists all active employees and information about each needed by certain plan providers for underwriting review and other purposes [i.e. "conditions not yet met for the customer to qualify"]. In step S11, if evidence	Warady's description of "information about each [employee] needed by certain plan providers for underwriting review and other purposes" does not teach the claimed feature of "conditions not yet met for the customer to qualify." Taken as a whole, these teachings relate to the generation of reports that list all active employees and information about each employee needed by certain plan providers for underwriting review and other purposes. Such reports are not "conditions not yet met for the customer to qualify" and appear to be nothing more than statistical information gathered for underwriting purporses. There is no indication of whether the underwriting relates to plans which the employees do or do not qualify for and certainly no indication of what conditions are not yet met. If anything, such information is being withheld from the potential customers under the guise of "underwriting." In short, these teachngs cannot form a proper basis for rejecting the present claims. It is also worth noting that claim 1 recites, "presenting a description of insurance plan options, . . ., the description of insurance plan options including an indication that the particular insurance plan being proposed is not currently configured for the customer, and an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan." In

	of insurability or other prerequisites are required to be provided by the employee for approval of a requested benefit, the benefit plan administrator or plan provider <u>notifies the employee</u> [i.e., provides an indication of conditions not yet met] and control in such cases passes to step S12. (*Examiner's interpretation is added in brackets, and emphasis/underlining is added by the Examiner*)	other words, claim 1 requires that "an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan" <u>be presented in the generated customized proposal</u> for the customer.

Warady's "information about each [employee] needed by certain plan providers for underwriting review and other purposes" may be included in an "Employee Census Report," but is certainly <u>not</u> presented in the blank enrollment form (the purported customized proposal for each employee).

Thus, even if the "information" described by Warady can somehow be considered "an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan," that information still would not be presented in a description of insurance plan options of a customized proposal as required by claim 1 and so Waraday's teachings would still be insufficient to warrant a rejection of the claims.

Finally, the Examiner's contention that <u>notifying the employee</u> that evidence of insurability or other prerequisites are required to be provided by the employee for approval of a requested benefit somehow teaches the claimed feature of "an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan," is not supported by the reference.

Warady specifically indicates that if evidence of insurability or other prerequisites are required to be provided by the employee for approval of a requested benefit, *the benefit plan administrator or plan provider notifies the employee*. The notification is <u>not</u> communicated in the enrollment form, which the examiner asserts is a customized proposal |

| | | for each employee. Indeed, the notification comes _after_ the employee has already enrolled in certain plans.

Therefore, even if one incorporates Waraday's teachings regarding notification, one does not arrive at the presently claimed invention because there is no "indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan." |
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For at least the above reasons, Appellant submits that Warady does not disclose the second claimed indication feature, that of "an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan."

B. NO PRIMA FACIE CASE MADE FOR "DETERMINING" FEATURE OF INDEPENDENT CLAIMS

Independent claim 1 recites, in part, "<u>determining</u> if a particular insurance plan <u>may be proposed but is not currently configured for</u> the customer" (_emphasis added_). Contrary to the Examiner's contention, Warady does not teach this feature.

Examiner's Answer		Appellant's Reply
Citation	Relevant Quotations	
Warady, at column 9, line 58 to column 10, line 8	In step S2, the health and welfare benefit enrollment and billing <u>system</u> 1 generates a blank enrollment form <u>for each employee described in the employee data files 20 and eligible</u> to receive one or more	It is worth noting that the Examiner cites these same passages of Warady as disclosing the two distinct indication features. Nothing in the Answer indicates why these (supposedly) indication features also teach the separate determining feature of the independent claims. That is, the Answer appears to intentionally

	benefits. The blank enrollment forms are generated according to the data and instructions entered into the benefit files 10, the employee data files 20, the sponsor file 30, and the code file 40 in step S1 and are <u>individualized</u> for each employee to include, for example, <u>all benefit plans and coverage options that are available to be selected by the employee</u> [i.e. "proposed but not currently configured for the customer"] as well as prices and credits (if any) associated with each benefit plan and coverage option. Again, the information included in each enrollment form <u>can be based</u> [i.e. "proposed but not currently configured for the customer"], for example, on relevant characteristics of the employee, such as job classification, division, work location, age and salary, and rules established by the employer. An example of a blank enrollment form is shown in FIGS. 7a-7e. (*Examiner's interpretation is added in brackets, and emphasis/underlining is added by the Examiner*)	disregard the explicit and separate determining feature of claim 1, and thereby fails to set out a *prima facie* case of obviousness . In any event, the same reasons as to why Warady does not disclose the first indication feature apply equally to a conclusion that Warady does not teach "a particular insurance plan may be proposed but is not currently configured for the customer," as recited in the determining step of claim 1.
Warady, at column 12, line 65 to column 13, line 12	Finally, as an additional feature to facilitate efficient reporting to participating plan providers of accurate information needed about participating employees, the health and welfare benefit enrollment and billing system 1 can create various supplemental reports. These supplemental reports can include, for	These statements in the Answer fail to articulate why the determining feature is taught by Warady and other cited art. Consequently, there has been no *prima facie* case of obviousness established. Further, for similar reasons to those set forth above regarding the second indication feature, Warady does not disclose "a particular insurance plan may be proposed but is not

example, an "Underwriters' Exception Report," which is generated periodically (typically monthly or with each billing statement) and which lists employees having exceptional circumstances, such as those awaiting evidence of insurability, those on disability, and those whose employment terminated during the period, and an "Employee Census Report," which is generated on demand and which lists all active employees and <u>information about each needed</u> by certain plan providers for underwriting review and other purposes [i.e. "proposed but not currently configured for the customer as conditions not yet met for the customer to qualify"]. In step S11, if evidence of insurability or other prerequisites are required to be provided by the employee for approval of a requested benefit, the benefit plan administrator or plan provider notifies the employee and control in such cases passes to step S12. (*Examiner's interpretation is added in brackets, and emphasis/underlining is added by the Examiner*)	currently configured for the customer," as recited in the determining step of claim 1.

          For at least the above reasons, Appellant respectfully submits that Warady does not disclose the claimed feature "<u>determining</u> if a particular insurance plan may be proposed but is not currently configured for the customer" (*emphasis added*).

III. INDEPENDENT CLAIMS 50-52

Claims 50-51 recite, in part, "generating a customized proposal in the computer system that is _different_ from the stored insurance products by the comparing the customer data and the determining of the particular insurance plan" (_emphasis added_). Claim 52 recites, in part, "generate a customized proposal that is _different_ from the stored insurance products by the comparing customer data and the determining of the particular insurance plan" (_emphasis added_).

A. LOCKWOOD DOES NOT TEACH "GENERATING"

The Answer cites Lockwood for teaching the above-referenced features of the claims. In fact, Lockwood, at column 3, lines 40-42, states, "[t]he system as applied to the insurance industry is arranged to give _personalized insurance quotations_, make sales and take orders . . ." (_emphasis added by Examiner_). Contrary to the Examiner's assertions, giving personalized insurance quotations does not teach the claimed feature of "generating a customized proposal in the computer system that is different from the stored insurance products."

To understand why this is so, consider that at column 5, line 65 to column 6, line 32, Lockwood provides a sequence of operations for a giving the personalized quote. As part of that sequence,

> (6) Central data processing center performs insurance quote
> calculations, up-dates a quote file, and relays the information
> back to the terminal;

Notice that the central data processing center merely performs insurance quote calculations based on _stored quotations and services, consequently, any_ personalized quotations that are produced from the calculations and subsequently displayed to the customer must be the _same_ as the stored quotations. In other words, Lockwood is displaying stored quotations to the customer after

retrieving same from a storage device. This is precisely the opposite of the claimed feature of generating a customized proposal that is _different_ from the stored insurance products.

The Examiner's contention regarding any teachings by Lockwood concerning, "as a result of comparing the customer data, it is only an extracted subset of the stored information, and therefore different from the stored information that is used to present the customer with the personalized insurance product information," does not alter this conclusion. As discussed on page 21 of the Appeal Brief, at column 2, lines 47-59, Lockwood clearly describes offered services (personalized insurance quotations) that are the _same_ as the stored information (as the services offered by the institution) in Lockwood. Thus, Lockwood does _not_ teach "generating a customized proposal in the computer system that is _different_ from the stored insurance products" (_emphasis added_).

B. WARADY DOES NOT TEACH "GENERATING"

Notwithstanding the contentions set forth in the Answer, Warady does not teach the claimed feature of "generating a customized proposal in the computer system that is different from the stored insurance products." Instead, Warady discloses modifying stored health and welfare benefit data and extracting the modified data. As such, Warady's extracted data is _the same_ as its stored data. In other words, Warady is merely a typical Human Resources type of system that allows the user to expressly modify personal data already resident in the system in order to update that system. In contrast, the claimed invention provides a potential customer with a variety of customizable variables applicable to a variety of products so that the customer can create a customized proposal that is different from the stored insurance products.

The distinction from the claimed invention is made clear by considering the disclosure

provided by Warady at column 9, line 59 to column 10, line 6:

> In step S2, the health and welfare benefit enrollment and billing
> system 1 generates a blank enrollment form for each employee
> described in the employee data files 20 and eligible to receive one or
> more benefits. The blank enrollment forms are generated according
> to the data and instructions entered into the benefit files 10, the
> employee data files 20, the sponsor file 30, and the code file 40 in
> step S1 and are individualized for each employee to include, for
> example, all benefit plans and coverage options that are available to
> be selected by the employee as well as prices and credits (if any)
> associated with each benefit plan and coverage option. Again, the
> information included in each enrollment form can be based, for
> example, on relevant characteristics of the employee, such as job
> classification, division, work location, age and salary, and rules
> established by the employer. An example of a blank enrollment form
> is shown in FIGS. 7a-7e. (*emphasis added*)

This passage indicates the blank enrollment forms are generated according to the data and
instructions entered into the benefit files. In other words, the quotations provided in the
"generated" enrollment forms are the same as the quotations entered (saved) in the benefit files.
Contrary to the Examiner's conclusion that the above passage teaches the claimed generating
feature, then, Appellant submits that Warady teaches exactly the opposite. The proposals
produced by Warady's system are the same as the stored proposals and so there cannot be any
generation of "a customized proposal in the computer system that is different from the stored
insurance products."

C. THE COMBINED DISCLOSURES OF THE REFERENCES DO NOT TEACH
"GENERATING"

The Examiner asserts that "Appellant appears to view the applied art separately, without
considering the knowledge of average skill in the art, and further fails to appreciate the breadth of

the claim language that is presently recited." Answer at p. 35. This is a mischaracterization of the Appellant's true position. Appellant has steadfastly maintained that claims 50-52 would not have been obvious to one of ordinary skill in the art at the time the invention was made over the combination of Lockwood and Warady See, e.g., Appeal brief at p. 21, under the heading "Independent claims 50-52 are not obvious over the combination of Lockwood and Warady and Tyler." As discussed above, the primary reference, Lockwood, does not disclose the claimed generating feature of claims 50-52, and Warady does not remedy this deficiency. The Examiner has never contended that the generating feature is disclosed by Tyler and so this is tantamount to admitting that Tyler does not do so. If none of the references, Lockwood, Warady or Tyler, teach or suggest the features of the claims at issue, it follows that the combination of these references cannot teach or suggest these features. Accordingly, even if one were to combine the teachings of the references the deficiencies noted herein and in the Appeal Brief would remain.

IV. DEPENDENT CLAIMS 2-6, 8-10, 20-29, 31-39, 41-49, 53 and 54

Appellant respectfully submits that dependent claims 2-6, 8-10, 20-29, 31-39, 41-49, 53 and 54 are patentable for, at a minimum, the same reasons as their respective base claims, as well as on their own merits. Appellant thanks the Examiner for correcting an error on page 23 of the Appeal Brief regarding the indication of the dependent claims.

V. CONCLUSION

The Examiner has admitted that Lockwood and Tyler fail to disclose the two indication features of the claims on appeal. Warady does not remedy this deficiency. Hence, the combination of Lockwood, Warady and Tyler does not teach or suggest the two indication features of the claims

on appeal.

Additionally, the combination of Lockwood, Warady and Tyler does not teach or suggest the feature, "generating a customized proposal in the computer system that is different from the stored insurance products by the comparing the customer data and the determining of the particular insurance plan" as required by claims 50-52.
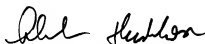
Accordingly, Appellant respectfully requests that the Board reverse the Examiner's rejections and remand this application to the Examiner for issuance of a Notice of Allowance.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this Reply Brief.

Should the Examiner have any questions or comments regarding this matter, the undersigned may be contacted at the below-listed telephone number.

Respectfully submitted,

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